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IN THE UNITED STATES PATENT OFFICE  
Office of Petitions

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In re Application of:

James W. Forbes

Ser. No. 09/804,406

Filed 12 March 2001

Now US Pat. 6,659,017 B2

Attorney Docket 5699-32

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OFFICE OF PETITIONS

Attn: Karen Creasy

## RESPONSE TO DECISION ON PETITION


This paper is filed responsive to the decision mailed 21 January 2004, a copy of which is attached. As it is mailed within one month of the decision (February 21 having occurred on a Saturday), it is believed to be timely filed.

Although the decision dismisses the petition as moot, due to issuance of the patent, applicant notes for the record that the procedure followed in this matter is consistent with the procedure disseminated on 2 February 2004 as "Revised Procedures for Papers Requiring Immediate Attention" by Stephen G. Kunin, a copy of which is attached.

It is understood from the decision on petition that the instant attempt to make a late claim of priority on US appln Ser. No. 09/705,056, filed on 2 November 2000, and now abandoned, may be achieved by submitting a certificate of correction and the appropriate fee. Accordingly, the certificate of correction is attached and the fee may be charged to Deposit Account 15-0450. It is believed that all additional paperwork necessary for entry of the priority claim was provided in the papers accompanying the petition in December 2003.

Please contact the undersigned attorney at 330/864-5550 if there are any questions on this matter.

Respectfully submitted,

  
Stephen L. Grant  
Reg. No. 33,390

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20590  
WWW.USPTO.GOV



Bib Data Sheet

CONFIRMATION NO. 1

<b>SERIAL NUMBER</b> 09/705,056	<b>FILING DATE</b> 11/02/2000 <b>RULE</b>	<b>CLASS</b>	<b>GROUP ART UNIT</b> 3617	<b>ATTORNEY DOCKET NO.</b> 5699-23
<b>APPLICANTS</b> James W. Forbes, Ontario, CANADA;				
** CONTINUING DATA *****				
** FOREIGN APPLICATIONS *****				
IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** 02/06/2001				
Foreign Priority claimed <input type="checkbox"/> yes <input checked="" type="checkbox"/> no	35 USC 119 (a-c) conditions met <input type="checkbox"/> yes <input checked="" type="checkbox"/> no <input type="checkbox"/> Met after Allowance	STATE OR COUNTRY CANADA	SHEETS DRAWING 31	TOTAL CLAIMS 31
Verified and Acknowledged	Examiner's Signature <i>[Signature]</i> Initials <i>[Initials]</i>			INDEPENDENT CLAIMS 9
<b>ADDRESS</b> 021324				
<b>TITLE</b> Dropped deck center beam rail road car				
<b>FILING FEE RECEIVED</b> 1518	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:		<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees ( Filing ) <input type="checkbox"/> 1.17 Fees ( Processing Ext. of time ) <input type="checkbox"/> 1.18 Fees ( Issue ) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit _____	

JAN 23 2004



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Paper No. 23

HAHN LOESER & PARKS, LLP  
TWIN OAKS ESTATE  
1225 W. MARKET STREET  
AKRON OH 44313

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OFFICE OF PETITIONS  
ON PETITIONIn re Application of  
James W. Forbes  
Application No. 09/804,406  
Filed: March 12, 2001  
Attorney Docket No. 5699-32  
5699.00032

This is a decision on the petition, filed December 4, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee. This application issued into Patent No. 6,659,016 on December 9, 2003.

The petition is **DISMISSED** as moot.

Unfortunately, the petition reached the appropriate official for decision after the patent issued on the above-identified application.<sup>1</sup> The inconvenience caused petitioner in this matter is sincerely regretted.

The Request for Continued Examination (RCE) submitted with the petition is not effective and will not be entered since the petition to withdraw from issue is dismissed.

Petitioner's attention is also directed to 37 CFR 1.313(d), which states: A petition under this section [37 CFR 1.313(c)] will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue."

A decision on the petition under 37 CFR 1.78(a)(3) will be held in abeyance pending submission of a certificate of correction and \$100 fee therefor. In this regard, petitioner's attention is directed to MPEP 1481.

Applicant is given **ONE (1) MONTH** from the mail date of this decision to reply to the above.

<sup>1</sup> The instant petition and application file was received in the Office of Petitions on January 13, 2004 (after issuance of the instant application into a patent), the deciding official for petitions to withdraw from issue after payment of the issue fee under 37 CFR 1.313(c).

Application No. 09/804,406

-2-

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, Va 22313-1450

**By hand:** Customer Window located at:  
  
2011 South Clark Place  
Crystal Plaza Two Lobby  
Room 1B03  
Arlington, VA 22202

**Central Fax:** (703) 872-9306  
ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8859.

*Karen Creasy*

Karen Creasy  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

**REVISED PROCEDURES FOR PAPERS REQUIRING IMMEDIATE ATTENTION**

On October 28, 2003 the Office published new procedures for the centralized delivery of documents (see *Centralized Delivery and Facsimile Transmission Requirements for Patent Application Related Correspondence*, 1275 Off. Gaz. Pat. Office 200 (Oct. 28, 2003)).

To facilitate processing of certain papers requiring immediate attention, Section B. of the above-mentioned Official Gazette notice is revised as follows:

**B. Papers Requiring Immediate Office Attention (Hand-carried and Facsimile Transmissions)**

Applicants are advised and encouraged to follow the directions below for the listed, and only the listed, document types. Special procedures will be followed for these documents after submission. No special marking of these documents is required, notwithstanding a statement to the contrary in the above-mentioned Official Gazette notice.

1. **Petitions for express abandonment to avoid publication under 37 CFR 1.138(c).**
  - a. The applicant may mail the petition to Mail Stop PGPub-ABD.
  - b. The applicant may transmit the petition by facsimile directly to the Pre-Grant Publication Division at 703-305-8568.
  - c. The applicant may hand-carry the petition to the Pre-Grant Publication Division at 2231 Crystal Drive, Room 905, Arlington, VA 22202.

Because a petition under 37 CFR 1.138(c) will not stop publication of the application unless it is recognized and acted on by the Pre-Grant Publication Division in sufficient time to avoid publication, the applicant should use either method (b) or method (c) in all instances where the projected publication date is less than 3 months from the date of the petition. All submissions under 37 CFR 1.138(c) should be made at least 4 weeks prior to the projected publication date.

2. **Petitions to withdraw an application from issue under 37 CFR 1.313(c).**
  - a. The applicant may mail the petition to Mail Stop Petitions.
  - b. The applicant may transmit the petition by facsimile to the Central Facsimile Number (703) 872-9306.
  - c. The applicant may hand-carry the petition to the Office of Petitions, Crystal Plaza 4, at 2201 South Clark Place, Room 3C23, Arlington, VA 22202.

Applicants are strongly advised to hand-carry the petition to the Office of Petitions to allow sufficient time to process the petition and if the petition can be granted, withdraw the application from issue. While a petition to withdraw an application from issue may be granted as late as 1 day prior to patent issue date, to avoid publication and dissemination, the petition decision must be granted at least 3 weeks prior to the issue date.

3. **Request for Expedited Examination of a design application (Rocket Docket).**

- a. The procedures of 37 CFR 1.155 and elaborated upon in MPEP 1504.30 should be followed.
- b. In brief, design patent applicants seeking expedited examination may file a design application in the Office together with a corresponding request under 37 CFR 1.155 by hand-delivering the application papers and the request directly to the Design Technology Center (TC) Director's office. The address of the Director's Office is changing in mid 2004, so phone the Office of the Director of TC 2900 just before hand submitting the application. The phone number will be changing also, but will be available on the USPTO web site, [www.uspto.gov](http://www.uspto.gov). For applicants who choose to file a design application and the corresponding request under 37 CFR 1.155 by mail, the envelope should be addressed to:

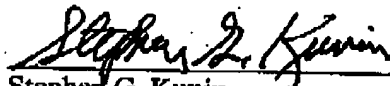
Mail Stop Expedited Design  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA, 22313-1450

These procedures will help assure that these time-critical documents will be considered in time for processing. All other documents submissions should follow the procedures listed in the referenced publication *Centralized Delivery and Facsimile Transmission Requirements for Patent Application Related Correspondence*, 1275 Off. Gaz. Pat. Office 200 (Oct. 28, 2003).

For further information on a petition or design patent application, contact the office to which the petition was addressed. For information on this notice, contact Jay Lucas at [Jay.Lucas@uspto.gov](mailto:Jay.Lucas@uspto.gov) or Michael Lewis at [Michael.Lewis@uspto.gov](mailto:Michael.Lewis@uspto.gov).

Date:

February 2, 2004



Stephen G. Kunin  
Deputy Commissioner for  
Patent Examination Policy

PTO/SB/21 (08-03)

Approved for use through 07/31/2008. OMB 0851-0031  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/804,406	<b>RECEIVED</b> <b>CENTRAL FAX CENTER</b> <b>FEB 23 2004</b> <b>OFFICIAL</b>
	Filing Date	March 12, 2001	
	First Named Inventor	James W. Forbes	
	Art Unit	3617	
	Examiner Name	Jules, Frantz, F.	
Total Number of Pages in This Submission	7	Attorney Docket Number	115699-32

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Response to Decision on Petition and Certificate of Correction
Remarks FAXED TO 703-308-872-9306 <b>ATTN: OFFICE OF PETITIONS</b>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Stephen L. Grant; Hahn Loeser & Parks LLP
Signature	<i>[Signature]</i>
Date	23 FEB 2004

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. Washington, DC 20231 on this date:			
Typed or printed name	Stephen L. Grant		
Signature	<i>[Signature]</i>	Date	02/23/2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

#25

PTO/SB/44 (07-03)

Approved for use through 01/31/2004, OMB 0651-0033

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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(Also Form PTO-1050)UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTIONPATENT NO : 6,659,017 B2  
DATED : December 9, 2003  
INVENTOR(S) : James W. Forbes

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On Title Page, Item 62, Related US Application Data, insert:

--Continuation in Part of 09/705,056, filed November 2, 2000, now abandoned.--

At Col. 1, Line 3, insert:

--This application is a continuation - in-part of application Serial No. 09/705,056, filed November 2, 2000, now abandoned.--

MAILING ADDRESS OF SENDER:  
Hahn Loeser & Parks LLP  
1225 W. Market Street  
Akron, OH 44313

PATENT NO. 6,659,017 B2

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→ 0

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.